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In re application of :
James D. Pylant et al. :
Application No. 10/620282 :
Filed: July 14, 2003 :
For: BARE DIE TRAY CLIP :

DECISION ON PETITION
TO VACATE FINAL
RESTRICTION REQUIREMENT

This is a decision on the petition, filed December 21, 2005, under 37 CFR §1.181, seeking review of the decision of the primary examiner. Petitioner requests vacating the species portion of the restriction/election requirement dated June 7, 2005 and to examine all of the apparatus claims.

The petition is **DENIED**.

A review of the file record reveals in an Office Action dated June 7, 2005, an election/restriction requirement was made between claims apparatus and method claims. The Petitioner elected the apparatus, without traverse. The election/restriction requirement further required an election between four species:

- Species 1, represented by figures 5-7
- Species 2, represented by figure 8
- Species 3, represented by figure 9
- Species 4, represented by figure 10.

The Petitioner elected species 1, with traverse, on July 20, 2005, and received an Office action on the merits of species 1 on December 1, 2005, which addressed Petitioner's arguments, and made the restriction/election requirement final and withdrew claims 5-7, 12, 13, 20-22, 24, 25 and 27.

The Petitioner states that all of the species are classified in Class 206, and that the Examiner could easily search all of the subclasses for that art that would be relevant to each species. Further, each of the species operate in the same manner, the species share common design features, and all of the species function as a unitary clip

Although Petitioner states the species overlap in design, function, and operation (arguments 2, 3, and 4), Petitioner stops short of stating that the species are not patentably distinct from each other. Therefore, both Examiner and Applicant consider that the species are patentably distinct. Where an application includes claims directed to different embodiments or species that could fall within the scope of a generic claim, restriction between the species may be proper if the species are independent or distinct (MPEP 806.04). A requirement for restriction is permissible if there is patentable distinction and there would be a serious burden on the Examiner (MPEP 808.01 (a)).

With regard to burden on the Examiner, the Examiner must show by appropriate explanation what the burden entails. In this instance, the Examiner explained in response to the traverse that the original claims received an initial search, and that claimed invention at the time of the restriction contained limitations, which would require additional search beyond that which had already been conducted.

It is clear from the Office action dated December 1, 2005, the Examiner fully considered and addressed the arguments submitted by the applicants. It is also determined the restriction/election requirement between species is appropriate according to the MPEP and rules of practice.

SUMMARY: The Petition to Vacate the Restriction Requirement and examine all the claims present is **DENIED**.



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